

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Bong-Jin LEE, et al.

Serial No.: 08/876,179

Examiner: GUSHI, ROSS

Filed: 13 June 1997

Art Unit: 2833

For: A HARD DISK DRIVE WITH CONNECTORS THAT SIMPLIFY ASSEMBLY  
(As Amended)



**TRANSMITTAL OF APPELLANT'S BRIEF FEE**

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

Sir:

Accompanying this transmittal is a check drawn to the U.S. Department of Treasury in the amount of \$300.00 for the filing a Brief in support of a Notice of Appeal on 7 June 1999. Should any additional fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 in that amount. Please inform the Applicant of any transactions involving the Deposit Account.

Respectfully submitted,

  
\_\_\_\_\_  
Robert E. Bushnell  
Attorney for Applicant  
Reg. No.: 27,774

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Washington, D.C. 20005  
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Folio: P54596  
Date: 9 August 1999  
I.D.: REB/mf

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1        15. The hard disk drive of claim 12, further comprised of said terminals being hook  
2        shaped.

1        16. The hard disk drive of claim 12, further comprised of said terminals being V-shaped.

1        17. The hard disk drive of claim 12, further comprised of said first connector and said  
2        second connector each being a 14 pin type of connector.

1        18. The hard disk drive of claim 12, further comprised of said contacts and said terminals  
2        each being a 4 pin type of connector.

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For: A HARD DISK DRIVE WITH CONNECTORS THAT SIMPLIFY ASSEMBLY  
(as amended)



**PETITION UNDER 37 C.F.R. §1.181**

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

Sir:

Applicant respectfully petitions from the failure of the Examiner in the Advisory action of 14 May 1999 (Paper No. 14) to enter Applicant's Amendment After Final filed on 15 April 1999, and as reasons therefor states that:

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### **STATEMENT OF FACTS**

1. On June 13, 1997 Applicant filed application with 11 claims in the U.S. Patent & Trademark Office.
2. On July 22, 1998 the Examiner issued a first Office action (Paper No. 5) where all eleven (11) claims were rejected under 35 U.S.C. §112, second paragraph, 35 U.S.C. §102 and 35 U.S.C. §103.
3. On October 22, 1998, Applicant filed an Amendment to the outstanding Office action wherein Applicant amended Claims 1 through 8 and Claims 10 and 11, canceled Claim 9 and added Claims 12 through 18.
4. On January 5, 1999, the Examiner issued a final Office action (Paper No. 7) rejecting Claims 1 through 8 and 10 through 18 under 35 U.S.C. §112, first paragraph, 35 U.S.C. §112, second paragraph, 35 U.S.C. §102 and 35 U.S.C. §103.
5. On April 5 1999, Applicant filed an Amendment under 37 C.F.R. §1.116(b) amending Claims 1, 3, 6, 8, and 12 to overcome the 35 U.S.C. §112, first and second paragraph rejections. In addition, Applicant argued the art rejections of the claims.

6. On April 16, 1999 the Examiner issued an Advisory action (Paper No. 11) where the Examiner rejected again all the claims and refused to enter any of the amendments after final.
7. On April 27, 1999 Applicant filed a Request for Consideration After Final to try to enter the amendments after final.
8. On May 14, 1999, the Examiner issued a second Advisory action (Paper No. 14) repeating his prior Advisory action by rejecting all the claims and refusing to enter any of the amendments after final.

#### ARGUMENTS/REMARKS

In Paper Nos. 11 and 14, the Examiner stated that all of the claims, 1 through 8 and 10 through 18 remain rejected and the Examiner refused to enter any of the amendments after final because the Examiner states:

"applicant's arguments advocating the entering of amendments after final rejection are not persuasive; the amendments regarding first and second circuit boards and automatic engagement are new matter requiring substantial consideration."

Regarding the claim that the first and second circuits board are considered new matter, Applicant points out that the claims prior to final amendments state "a printed circuit board" and "a

printed circuit board assembly." Thus, the claim already contained two separate circuit boards. This is evidenced by Claims 1, 6, and 12. For these reasons, the Examiner was in error in stating that the first and second circuit boards are new matter.

Regarding the second claim by the Examiner that automatic engagement is new matter, Applicant cites the Summary of the Invention section of the specification, page 3, lines 3 and 4 where it states, "an electrical connection between a head disk assembly in a flexible printed circuit board is automatically made upon mounting a printed circuit board on a head/disk assembly." Applicant cites original Claim 1 as filed on June 13, 1997 where it says "said second plurality of connector pins being automatically connected when said first connector is connected." Claim 6 of the originally filed application says "said second connector automatically electrically connecting said printed circuit board to said head/disk assembly when said first connector connects said printed circuit board to said head/disk assembly." Claim 9 of the originally filed application of June 13, 1997 says "said connector automatically connecting said head disk assembly to said printed circuit board when attaching said hard disk drive to said head disk assembly." Thus, it is not new matter that the term "automatic" is to be entered in the Amendment After Final in the claims.

Finally, the Examiner claims that entry of the Amendment After Final would require substantial consideration. However, Applicant quotes from the Examiner's final Office action (Paper No. 7) where he states "again, either there are two or more printed circuit boards which are not

distinguished in the claims, or there is a single circuit board which is claimed multiple times in the same claim. Independent claims 6 and 12, although worded slightly differently, have the same ambiguities." Thus, the Examiner was already aware of the fact that there might have been more than one printed circuit board in Applicant's claims and the Examiner should have been prepared to examine the possibility of more than one circuit board at the stage in prosecution.

For these reasons, Applicant contends that the Examiner's assertion that the substantial consideration will be imposed on the Examiner if the amendments after final were entered, is without merit.

**RELIEF REQUESTED**

In view of the above, the Commissioner is respectfully requested to:

- A. Enter the Amendment After Final filed by Applicant on April 5, 1999; and
- B. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,

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Robert E. Bushnell  
Attorney for the Applicant  
Registration No.: 27,774

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AF/GAV  
2833

# FEE TRANSMITTAL

Patent fees are subject to annual revision on October 1.

These are the fees effective October 1, 1997.

Small Entity payments must be supported by a small entity statement, otherwise large entity fees must be paid. See Forms PTO/SB/09-12. See 37 C.F.R. §§ 1.27 and 1.28.

## Complete If Known

		Application Number	08/876,179
		Filing Date	13 June 1997
		First Named Inventor	Bong-Jin LEE, et al.
		Examiner Name	GUSHI, ROSS
		Group/Art Unit	2833
TOTAL AMOUNT OF PAYMENT	(\$ 300.00)	Attorney Docket No.	P54596

## METHOD OF PAYMENT (check one)

- The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit Account Number: 02-4943

Deposit Account Number: \_\_\_\_\_

Charge Any Additional Fee  Charge the Issue Fee Set in 37 C.F.R. §1.18 at the Mailing of the Notice of Allowance.

## 2. ■ Payment Enclosed: (CHECK #33437)

- Check  Money Order  Other

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity	Small Entity						
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid		
101	760	201	380	Utility filing fee	\$		
106	310	206	155	Design filing fee	\$		
107	480	207	240	Plant filing fee	\$		
108	760	208	380	Reissue filing fee	\$		
114	150	214	75	Provisional filing fee	\$		
<b>SUBTOTAL (1)</b>		<b>(\$ 0.00)</b>					
<b>2. EXTRA CLAIM FEES</b>							
		Extra Claims	Fee from below	Fee Paid			
Total claims	-20** =	x	=	144	580		
Independent Claims	- 3** =	x	=	122	130		
Multiple Dependent			=	123	50		
** or number previously paid, if greater; For Reissues, see below							
<b>Large Entity</b> Small Entity							
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description			
103	18	203	9	Claims in excess of 20			
102	78	202	39	Independent claims in excess of 3			
104	260	204	130	Multiple dependent claim, if not paid			
109	78	209	39	** Reissue independent claims over original patent			
110	18	210	9	** Reissue claims in excess of 20 and over original patent			
<b>SUBTOTAL (2)</b>		<b>(\$ 0.00)</b>					
<b>** Reduced by Basic Filing Fee Paid</b>							
<b>SUBTOTAL (3)</b>					<b>\$300.00</b>		

## SUBMITTED BY

## Complete (if applicable)

Typed or Printed Name	Robert E. Bushnell, Esq.			Reg. Number	27,774
Signature		Date	9 August 1999	Deposit Account User ID	